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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 34

Application Number: 09/174,868
Filing Date: October 19, 1998
Appellant(s): MUSACCHIA, JOHN

Nelson R. Capes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 March 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The brief includes a statement that claims 1 and 3-18 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,607,091 MUSACCHIA 03-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The grounds of rejection as stated in the Final Rejection (paper No. 24, dated 24 September 2002), and are incorporated herein in their entirety by reference.

(11) Response to Argument

The present invention provides a game call that can be releasably secured around a hunter's thigh and used to call game using only one hand. As recited by the claims, a portion of the device provides a "...one-piece game call..." construction.

Appellant argues that Musacchia fails to disclose a "one-piece" game call construction. For this reason Appellant argues that the examiner has failed to provide a prima facie case of obviousness.

The examiner disagrees with Appellant's arguments for two reasons. First, Appellant argues a game call "...device...of unitary construction,..." (page 5, line 6), but fails to claim the disclosed invention in such a way as to obviate over the prior art of record. Second, if the examiner was to agree with Appellant's arguments, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)

With regards to the examiner's first point of argument, Musacchia discloses a universal game call comprising a one-piece construction. Musacchia discloses a holder (10) designed to accommodate a slate call (30), wherein said call (30) is firmly secured in place via a retainer element (44) (col. 4, lines 25-31 and lines 57-60). This arrangement forms a "one-piece" game call device, as shown by Figures 1, 5, & 6. Moreover, the above holder (10) can be utilized with multiple types of game calls (col. 6, lines 48-60) (Figs. 7-10). As stated earlier, the universal holder (10) via retainer element (44) forms a *one-piece* construction with any game call placed therein for use (Figs. 7-10).

With regards to the examiner's second point of argument, Musacchia discloses a holder (10) and separate game call devices that can be placed therein. In using appropriate known case law, it would have been obvious to one having ordinary skill in

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the art at the time the invention was made to integrally form the holding element (10) and game call device (30) together, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Thus, it is the examiner's position that the claimed invention involves only a mere integral formation of known components. More specifically, the patented holding assembly (component I) and call devices (component II) are identical in structure to the claimed holding assembly (component I) and call devices (component II). The examiner wishes to illustrate that the only difference in the patented invention and the claimed invention is in the "one-piece" formation of the two components.

In response to Appellant's contention that the Examiner has not responded to the Appellant's arguments and 37 CFR 1.132 Affidavit filed February 2, 2000, the Examiner submits that Appellant's arguments and 37 CFR 1.132 Affidavit have been given full consideration but they have not changed the Examiner's position.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

November 12, 2003

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